

Remarks/Arguments:

Petition to Revive for Unintentional Delay

The above referenced application was abandoned for failure to reply to the outstanding Office Action dated March 21, 2003. Enclosed herewith is a Petition to Revive for Unintentional Delay. The entire delay in responding to the Office Action dated March 21, 2003 from the due date to the filing of a grantable petition pursuant to this paragraph was unintentional.

Office Action

Request for Information

Section 2 of the Office Action recites that "[t]he Office requires submission of information or material reasonably necessary to properly examine the claimed invention." Specifically, the Office Action requests the following: 1) product publications from Applicant's assignee that discuss the claimed subject matter, 2) a description of how the claimed invention is an improvement over the prior art cited by Applicant, 3) an identification of what is being improved, and 4) an identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

With respect to item 1, Applicant's assignee has not produced any publications discussing the claimed subject matter.

With respect to item 2, the claimed invention, as amended, is directed to an in-vehicle device and an internet appliance. The in-vehicle device includes a first wireless interface and the internet appliance includes a second wireless interface for communicating with the first wireless interface. In addition, the internet appliance includes a plurality of communication interfaces for communicating with data resources. Thus, the in-vehicle device is able to communicate with data resources such as those available over the Internet through an internet appliance, thereby allowing the in-vehicle device to access the data resources whenever it is within communication range of a compatible internet appliance. Accordingly, Applicant contends that the in-vehicle device communication are improved over the prior art cited by Applicant.

With respect to item 3, the improvement is communication between an in-vehicle device and data resources using internet appliances.

With respect to item 4, Applicant is unaware of any use of the claimed invention at the time the application was filed.

Objection to the Abstract

The Abstract was objected to on the basis that it is not a single paragraph and is too long. Applicant has amended the abstract to overcome the objection.

35 U.S.C. §101 Rejections

Claims 19, 21, and 22 stand rejected under 35 U.S.C. § 101 on the basis that that "the claimed method does not recite a useful, concrete and tangible result." Claim 19 has been amended to clarify the claims. The steps recited in claim 19 as amended are as follows:

- a) communicating a plurality of digital content wirelessly between an in-vehicle device and an internet appliance;
- b) routing said plurality of digital content from said internet appliance to said data processing resource;
- c) determining at said data processing resource a plurality of return digital content responsive at least in part to said plurality of digital content;
- d) routing said plurality of return digital content to said internet appliance; and
- e) communicating said plurality of return digital content wirelessly between said internet appliance and said in-vehicle device for at least one of display within the vehicle or modification of a function of the vehicle.

Support for amended claim 19 is found throughout the specification and, specifically, at page 19, line 14 - page 21, line 4; page 100, lines 22-25; and page 113, lines 20-24. No new matter has been added.

Applicant contends that claim 19 as amended clearly recites structural interaction and provides a useful and concrete result. An in-vehicle device communicates with a data processing resource via an internet appliance. Digital content is communicated wirelessly between the in-vehicle device and the internet appliance and between the internet appliance and the data processing resource, which cannot be performed by a human. In addition, claim

19 sets forth a useful, concrete, and tangible result. Specifically, by communicating with the data processing resources via the internet appliance, the in-vehicle device is able to perform at least one of displaying digital content from a data processing resource or modifying a vehicle based on digital content where the digital content is based at least in part on digital content communicated from the in-vehicle device to the data processing resource. Accordingly, amended claim 19 includes structural interaction and produces a useful, concrete, and tangible result.

Claims 19, 21, and 22 also stand rejected under 35 U.S.C. §101 on the basis that "the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process." Applicant respectfully disagrees. Claim 19 recites five steps for communicating data between an in-vehicle device and a data processing resource via an internet appliance to display information or modify the vehicle. Accordingly, claim 19 sets forth steps involved in the process for the above recited use. Thus, since amended claim 19 includes structural interaction and produces a useful, concrete, and tangible result, Applicant requests that the rejection of claim 19 on these grounds be withdrawn.

Claims 22 has been amended for clarification. Support for amended claim 22 is found throughout the specification and, specifically, at page 19, line 14 through page 21, line 4; and page 25, line 12 through page 26, line 2. Claim 22 as amended recites a step that limits a step found in amended claim 19 and therefore is a step involved in a process to provide the useful, concrete and tangible result expressed above for claim 19. Thus, Applicant requests that the rejection of claim 22 under 35 U.S.C. § 101 be withdrawn as well.

35 U.S.C. §112, 1st ¶, Rejection

Claims 1-19 and 21-23 stand rejected under 35 U.S.C. §112, 1st ¶, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. The Office Action clarifies the rejection stating that "the claimed method and system of data communicating between at least one vehicle and at least one data processing resource [including] the features of communication interface device[s],... alternatively including digital content routing steps, are not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention." The Office Action further states that the

"specification recites this claimed concept but does not reasonably convey [the concept] ... such that one skilled in the art would be able to make or use the claimed invention."

Applicant respectfully disagrees with the rejection. With respect to claim 1, Applicant points to FIGs. 2C, 3, and 4 and the accompanying description in the specification of the application as originally submitted. FIG. 4 depicts an embodiment of the in-vehicle device (200). The in-vehicle device includes the first wireless connectivity interface, e.g., wireless modem 270, wireless phone transceiver 272, wireless phone interface 274, or wireless data link 276. FIG. 3 depicts an embodiment of the interface device 100. The interface device includes the second wireless connectivity interface, e.g., wireless modem 138, wireless phone transceiver 140, wireless phone interface 142, and wireless data link 144. In addition, FIG. 3 depicts communication interfaces, e.g., local area network (LAN) interface 146, universal serial bus (USB) port 156, network connection to Internet 136, etc. FIG. 2C depicts connections from the interface device 100 to data resources 356 over the Internet 362. Applicant contends that those of skill in the art would be able to produce a suitable in-vehicle device and communication interface device in accordance with the invention as claimed from the drawings depicted in FIGs. 4 and 3, respectively, and the accompanying descriptions. In addition, those of skill in the art would understand how to effectuate data communication between an in-vehicle device and a data resource in accordance with the claimed invention from the drawings depicted in FIGs. 2C, 3, and 4 and the accompanying description. Since those of skill in the art would be able to make and use the individual components and effectuate data communication therebetween, the subject matter of the invention as claimed in claim 1 is sufficiently described. Additionally, support for all other claims is likewise described in the detailed description. Accordingly, Applicant requests that the rejection of claims 1-19 and 21-23 based on this ground be withdrawn.

35 U.S.C. 112, 2nd ¶, Rejection

Claims 1-19 and 21-23 stand rejected under 35 U.S.C. 112, 2nd ¶, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action states that the "claimed method and system of data communicating ... fails to particularly point out and distinctly claim the subject matter ... because those steps are considered indefinite from the accepted definitions to those skilled in the art and it is unclear that the specification provides adequate antecedent basis for those steps." As discussed above with respect to the 35 U.S.C. 112, 1st ¶, rejection, the specification

provides adequate antecedent basis for the claims. Regarding whether one skilled in the art would consider the steps indefinite from the accepted definitions, Applicant believes that the Office Action is mistaken and respectfully traverses this rejection. If the rejection is maintained, Applicant requests additional details regarding which steps are considered indefinite from the accepted definitions of what terms and why these steps would be considered indefinite. Accordingly, Applicant requests that the rejection of claims 1-19 and 21-23 based on this ground be withdrawn.

35 U.S.C. §102 Rejections

Claims 1-19 and 21-23 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,848,373 (DeLorme et al.), U.S. Patent 6,157,317 (Walker) [The Office Action incorrectly identifies this patent as U.S. Patent No. 5,157,317, which was determined by reviewing form 1449 signed by the Examiner on March 17, 2003], U.S. Patent 6,166,627 (Reely), U.S. Patent 6,181,994 (Colson et al.), U.S. Patent 6,202,008 (Beckert et al.), U.S. Patent 6,246,672 (Lumelsky), U.S. Patent 6,266,614 (Alumbaugh), U.S. Patent 6,314,409 (Schneck et al.), U.S. Patent 6,331,825 (Ladner, et al.), and U.S. Patent 6,347,216 (Marko et al.).

Applicant respectfully disagrees with the rejection and contends that the claims are not clearly anticipated or suggested by these patents. For example, DeLorme, the first listed patent, relates to a mapping system for mapping GPS coordinates onto a map. In one embodiment, a vehicle involved in an accident transmits GPS coordinates to a central dispatch office that displays the location of the vehicle based on the transmitted GPS coordinates. DeLorme, however, is devoid of any teaching or suggestion of transmitting information back to the vehicle. Thus, the in-vehicle device of DeLorme is unable to communicate with data processing resources as claimed in independent claims 1, 13, and 19. In addition, Walker, the second listed patent, relates to disabling a vehicle using an output signal from a pager configured to disable the vehicle in response to a page. The pager, however, does not communicate with a data resource. Thus, the pager of Walker is unable to communicate with data processing resources, as claimed in independent claims 1, 13, and 19. The remaining patents each fail to teach or suggest the claimed invention as well. Applicant contends that these patents are arguably complex, describe inventions other than those claimed by Applicant, and are of questionable pertinence. Applicant points out that when a reference is complex or shows or describes inventions other than that claimed by Applicant, the particular part relied on

must be designated as nearly as practicable and the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. 37 CFR 1.104(c)(2). Accordingly, Applicant requests that this rejection be withdrawn.

Additionally, each of independent claims 1, 13, and 19 (and dependent claims 2, 12, 14, 18, and 22) were amended to recite that the communication interface device is an internet appliance. Support for this amendment is found throughout the specification and, specifically, on page 19, line 14 - page 21, line 4. None of the art of record appears to disclose, teach, or suggest communication between an in-vehicle device and a data resource via an internet appliance. The use of an internet appliance provides the advantage of enabling the in-vehicle device to communicate with data resources over the Internet using internet appliances connected to the Internet to enable communication whenever a compatible internet appliance is within wireless communication range. Accordingly, independent claims 1, 13, and 19 appear to be patentable over the art of record and, therefore, Applicant requests that this rejection be withdrawn for this additional reason.

Claims 3, 5-8, 10-12, 14-16, 18, 22, and 23 depend (either directly or indirectly) from one of claims 1, 13, and 19 and, therefore, contain each of the limitations of the independent claim from which they depend. Accordingly, claims 3, 5-8, 10-12, 14-16, 18, 22, and 23 are patentable over the cited art for at least the reason that the independent claims from which they depend are patentable. Accordingly, Applicant requests that the rejection of claims 3, 5-8, 10-12, 14-16, 18, 22, and 23 be withdrawn.

Claims 1-19 and 21-23 further stand rejected under 35 U.S.C. §102(b) based upon a public use or sale of the invention. The Office Action states that an "internet search and a trademark search has revealed that the claimed invention has been in public use or on sale for more than one year from the filing of the present inventions." From the information provided in the Office Action, it appears that the Office Action is referring to the trademarks "USA Technologies" and "Telematics." The Office Action requires Applicant to provide "the earliest release date and availability of the above mentioned trademarks by the assignee of the claimed invention," since an "issue of public use or on sale activity has been raised in this application." The assignee of the claimed invention is USA Technologies. None of USA Technologies' trademarks and the descriptions of those trademarks even mention the word Telematics. Applicant points out that the USA Technologies trademark was never used in conjunction with the claimed subject matter prior to the priority date of the application. Nonetheless, in an

attempt to fully reply, Applicant searched the trademark database of the United States Patent and Trademark Office (USPTO) for the trademark "USA Technologies" and the trademark "Telematics." A copy of our search of the Trademark Electronic Search System (Tess) is attached hereto as Exhibit A. The trademark name, trademark number, owner, first use data, and subject matter are summarized as follows:

| <u>Trademark Name</u> | <u>Number</u> | <u>Owner</u> | <u>First Use</u> | <u>Subject Matter</u> |
|-----------------------|---------------|---------------------|------------------|-----------------------|
| USA Technologies | 75392979 | USA Technologies | Nov. 13, 1996 | Vending Machine |
| USA Technologies | 74637231 | USA Technologies | Jan. 16, 1995 | Vending Machine |
| Telematics | 76413281 | ECI Telecom | Unknown | Server/Router |
| Telematics | 73503653 | Harcourt Brace Jov. | May 1984 | Magazine |
| Telematics | 73432381 | Telematics Intl' | March 24, 1982 | High Speed Bus |
| Telematics | 72440113 | Telematics Assoc. | May 1968 | Consulting |

None of Applicant's assignee's trademarks and apparently the "Telematics" trademarks owned by others are related to establishing communications between in-vehicle devices and data resources using an internet appliance as in amended claims 1, 13, and 19.

Applicant is unaware of any description of the claimed invention that reveals the claimed invention. As an example was not provided in the Office Action, Applicant is unable to provide further response to this rejections. If this rejection is maintained, Applicant requests examples from the internet and trademark database search results, to which Applicant would be happy to responds. Otherwise, Applicant respectfully requests that this rejection be withdrawn.

35 U.S.C. §103 Rejection

Claims 1-19 and 21-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over "an obvious variation of Examiner's personal experience." The applicant respectfully traverses this rejection. The Office Action relies on the instant Examiner's personal experience with police radio or taxi cab operations in making the rejection. The Office Action provides no other support for this rejection. Notwithstanding the lack of support for the rejection, police radio and taxi cab operations are not carried out using an internet appliance as recited in each independent claim (as amended) of the application, nor is such a modification taught or suggested. Accordingly, Applicant requests the rejection of claim 1-19 and 21-23 be withdrawn.

Obviousness-type Double Patenting Rejection

Claims 1-19 and 21-23 are provisionally rejected/rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending applications: 09/579,263, 09/593,881, 09/734,1229, or 09/802,842; and the claims of U.S. Patents: 6,389,337 and 6,505,095. The Office Action recites that "[a]lthough the claims are not identical, they are not patentably distinct from each other because those patented claims processes [sic] data and information communicatively in the same manner, using an obvious variation in terminology, to achieve the same result." Applicant will file appropriate Terminal Disclaimers as necessary to overcome this rejection once allowable subject matter is identified.

Conclusion

Accordingly, Applicant requests reconsideration of the claims, as amended. Applicant contends that the claims now pending are in condition for allowance, which action is respectfully requested.

Respectfully submitted,



Benjamin F. Leace; Reg. No. 33,412
Stephen J. Weed; Reg. No. 45,202
Attorney(s) for Applicant(s)

Attachments: Abstract
Exhibit A

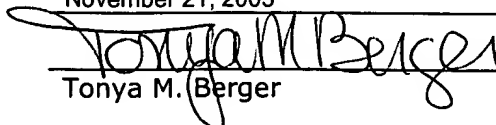
Dated: November 21, 2003

P.O. Box 980
Valley Forge, PA 19482
(610) 407-0700

The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. 18-0350 of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

November 21, 2003


Tonya M. Berger